REMARKS

I. OVERVIEW

The Final Rejection of October 5, 2005 approves certain amendments to the application but maintains rejections to the claims. Applicant has carefully studied the final rejection and submits the following with the Request for Continued Examination in an earnest effort to advance the application to allowance. Entry and consideration is respectfully requested.

II. SWEARING BEHIND COOK REFERENCE

The Office Action takes the position that Applicant's evidence of record is not sufficient to establish conception of the claimed invention prior to the effective date of the Cook cited reference. This is respectfully traversed for the following reasons.

1. Conception occurs when the means to solve a problem and the interaction between the means and the problem are established.

It is respectfully submitted that the § 131 Affidavit establishes this. Burroughs Wellcome Co. v. Barr Laboratories, Inc., 40 F.3d 1223, 1228 (Fed. Cir. 1994). It provides corroborated factual evidence that, ahead of the effective date of Cook, the Applicant was in possession of the claimed invention. The Applicant knew, as of the effective date of Cook, the problem. The problem was how to effectively teach sometimes massive and difficult information (e.g., government regulations) to persons (e.g. government employees). The means to solve the problem was making available to the user, for user-selection as he/she decided, additional instructional information relating to the subject matter being learned in the form of at least two levels of sophistication. In one embodiment, one level is high-level, simplified summaries of the information in prose or voice that is blunt and straight forward -- i.e., it is "plain" language.

Another level is more complex in words or voice. It is professorial instead of "plain". The basic learning model embodied in the claim is to make available to the learner two simulated "tutors". The learner has control over whether or not to use either simulated tutor, but they are both there and ready. As stated in the Applicant's specification, the learner has complete control over what level of sophistication he/she uses, if any, for each section being learned that has those options. *See* Applicant's specification, pg. 7, paragraph 3. The simulated tutors are available in essentially real time, like having a live tutor next to the learner. Specification pg. 9, paragraph 3. Another way that Applicant's method is described is like simulating a discussion of experts about the topic being learned. Specification pg. 11, paragraph 3. The learner essentially can control whether or not he/she "listens" to one or more virtual experts about the topic as a methodology for better learning of subject matter.

The evidence of record includes a document that is a drawing of exactly what was previously mentioned. *See* the flowchart attached to the back of Exhibit B of the Declaration of McKirchy filed July 13, 2005. The flowchart shows that either the plain ("Huh or Plain") simulated tutor or sophisticated ("Tell Me More or Enhanced") simulated tutor comments or explanations of the information to be learned is available any time and in any order to the person trying to learn the information.

As is fundamental, conception of an idea does not require details beyond a showing that the means to solve the problem and the interaction between the means and the problem are established. Burroughs, 40 F.3d at 1228. Therefore it is respectfully submitted conception has been established by the record. However, to further establish conception prior to the effective date of Cook, enclosed is a Supplemental Declaration of Karen McKirchy. It describes additional details about the circumstances surrounding the flow chart of Exhibit B of the July 13,

2005 McKirchy Declaration, its relationship to proof of conception, the problem being solved, and the solution in Applicant's claims.

2. The timing of conception is clearly established in the record and not rebutted.

Reconsideration of the decision that conception has not been proved prior to the May 22, 1996 Cook effective priority date is respectfully requested based on the materials herein and materials previously of record. It is agreed that corroborating evidence, over and above the inventor's own testimony, is normally required to show conception and that it must include the material limitations of the claimed invention. But such corroborating evidence is of record here.

Take, for example, method claim 1 as originally pending in the present application. Broken down to its essentials, it calls out:

a. a method for providing instruction to a user of an instructional program;

b. presenting an interactive instructional program having a plurality of sections or parts related to a subject or topic;

c. presenting additional instructional assistance options related to the section, where the options include information "in a form perceivable by the user at a first level of sophistication" or "in a form perceivable by the user at a second level of sophistication".

Applicant's specification provides examples of what might comprise the main instructional information to be learned by the user of the instructional program. One example is a set of regulations to be learned regarding use of a government purchase card. For example, the *verbatim* text of the regulations can be displayed to the user. The user may choose to learn the regulations from studying that *verbatim* language.

But Applicant's claim 1 then requires there to be "additional instructional options" available to help the user learn the main instructional information. Applicant's specification provides examples of what might comprise "additional instructional options". The user may choose any of the options to try to speed up, enhance, or otherwise help him/her learn the displayed regulation. These instructional options are essentially the two (or more) simulated tutors of different sophistication. Claim 1 outlines that the "additional instructional options", for at least one section, can comprise multiple levels of sophistication. See Specification, page 4. These levels of sophistication could reside in audio, video, graphic, or textual perceivable information. One specific embodiment of a first level sophistication is labeled "Huh?" -- text and audio of the text from "an older man, in a rough, gravelly or husky voice", or "cut-to-the-chase" manner. Applicant's Specification, page 17, first full paragraph. A second level of sophistication, called "Tell Me More" has text which is vocalized by "a woman in a calm, direct, authoritative, but patient and assuring voice .... like a respected, instructive professor." Additional levels are, of course, possible.

In general, claim 1 is basically a method of providing additional learning assistance to a person trying to learn, for example, a difficult subject matter, by allowing the person selectable access to a variety of learning assistance options (e.g. the simulated tutors of different sophistication). These options are immediately available to the user to allow the user to select what type of assistance he/she deems appropriate and desirable for that particular time and content. Applicant's specification details examples of such different "levels of sophistication"—one being gruff, straight to the point, unsophisticated assistance; the other being sophisticated, professorial, and patient.

The Declaration filed with the July 13, 2005 Response to Office Action, at Exhibit B, supplied the "information model" copyright registration TX-4-428-886 related to claim 1. The deposit accompanying the registration application was a flow chart of the idea of claim 1. It literally is entitled "Information Model" and "Topic Module". It relates to the basic instructional/computational strategy for the instructional help described in Applicant's claim 1. It is the same diagram as Figure 2 of Applicant's specification. It has a first column labeled "content". This column comprises three different types of content categories related to what is to be learned— (1) the "information" itself (*e.g.* the regulation to be learned); (2) questions about the information to be learned, or (3) answers and feedback regarding the questions about the regulation to be learned. It explicitly shows how the user can move out of any of these three "content" categories into additional instructional options of either of the two levels of sophistication of additional instructional information. Specifically, the user can move out of the content to either "Huh or Plain" level of additional instructional information (e.g. blunt, low sophistication tutor) or "Tell Me More or Enhance" level (e.g. professor-like, high sophistication tutor). It shows the user can select from those two levels of sophistication of instructional assistance at any time during the section (the "topic module") as needed or desired.

This copyright registration is tangible, demonstrative, competent corroboration of conception of the claimed invention. It was the deposit to a copyright registration which indicates completion of the invention prior to the effective date of the cited Cook reference. It is essentially analogous to a blueprint or high level block diagram in an inventor's notebook for a machine or process. It explicitly illustrates the idea of claim 1 of Applicant's application was sufficiently developed and that the inventor held the complete invention in her own mind upon creation of that information model. It would clearly suggest claim 1 to one of ordinary skill in

the art. No extensive research and experimentation would be needed. It contains every material feature or limitation of claim 1. Slip Track Systems Inc. v. Metal-Lite, Inc., 304 F.3d 1256 (Fed. Cir. 2002). As a point of fact, the diagram of the copyright registration is identical to Figure 2 of the specification of the present application, which is used to explain Applicant's invention. As held by the Federal Circuit, corroboration of conception can be as little as an e-mail proposing a research project. In re Jolley, 308 F.3d 1317 (Fed. Cir. 2002). The information model of Applicant's Figure 2 is much more than that. It discloses on its face the elements of Applicant's claim 1.

It is further pointed out that claim 1 is a method claim. In that context, as well as in the context of interactive programming and software, the document is clearly a competent, demonstrative, corroboration of claim 1. It is a flow chart for software, just as programmers routinely do for any software. Any question about this alleviated by the Declaration and other exhibits that explain the context of that flow chart. In short, the evidence of record establishes that the flow chart of Figure 2 of the present application was created and in tangible form at least as early as 1995, which was prior to the effective date of the Cook reference. But, moreover, the flow chart of Figure 2 of the present application was implemented in a functioning program and published in late October, 1995; again, earlier than the Cook effective date. The evidence of record provides a copy of the 1995 flow chart and a copy of the copyright registration establishing publication of a reduction to practice of Figure 2 prior to the Cook effective date. This is competent corroboration of the inventor's testimony about conception.

3. Reduction to practice is clearly established in the record and rebutted.

Similarly, reconsideration of the conclusion that reduction to practice has not been established is respectfully requested. The Federal Circuit has stated, "in order to establish actual

reduction to practice, the inventor must prove that he constructed an embodiment or performed a process that meet all the limitations of the claim, and that he determined the invention would work for its intended purpose." Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed. Cir. 1998).

Applicant has provided *prima facie* evidence showing reduction to practice of the instructional/computational strategy of the flow chart of Applicant's Figure 2 (discussed above) into an actual operating interactive computer program. This actual reduction to practice occurred prior to the effective date of Cook. It is not believed that any further evidence is required.

However, in response to the Examiner's suggestion, enclosed is another copy of U.S. Copyright Registration TX 4-428-886, including its deposit. Note the completion date of 1995. Note also the following with regard to the deposit. It explicitly calls out the flow chart of Applicant's Figure 2 in this code on the CD-ROM. The title of the program is "What You Will Learn". It describes it as a training product. On the second page there are examples of actual two levels of sophistication of additional instructional information—namely "plain" and "enhance". These are identical to the two levels set out in Applicant's Figure 2. It can be seen that the "plain" explanation comports to less sophisticated instructional assistance, whereas the "enhance" explanation is more sophisticated. Thus, these two levels of sophistication are generated by the code related to this instructional CD-ROM, an actual reduction to practice of Applicant's invention. The high level programming instructional/computational strategy of the conception document of Applicant's Figure 2 is directly revealed in this copyright registration deposit related to a CD-ROM instructional learning program. This shows actual reduction to practice of Applicant's claimed invention.

The record establishes both conception and actual reduction to practice. It is unrebutted through that record that the Applicant reduced the concept to practice by implementing it in

software that is now under license to various government agencies. Additionally, the filing of the application itself constitutes a constructive reduction to practice. Diligence has not been questioned but is supported in the record and unrebutted. Therefore, it is respectfully submitted that the record supports the swearing behind of the Cook cited reference.

III. SECONDARY INDICIA OF NON-OBVIOUSNESS

The final rejection makes the bare accusation that the evidence of record is insufficient to establish a secondary indicia of non-obviousness through commercial success. Reconsideration is respectfully requested.

It is rare that an invention is licensed for millions of users. The evidence of record establishes this. The record establishes at least:

a. The reason the various government agencies wanted the license is to better train employees on sometimes massive and confusing regulations. The declarations of record establish that the basic theory of explaining concepts regarding the regulations in "plain" versus "sophisticated" language provides better learning. The declarations establish that this model for learning was presented to the government when discussing a possible contract to provide computerized learning assistance to various government agencies. The declarations establish the basic difference between other programs and Applicant's programs was precisely that feature.

b. As discussed in the preceding section, the "invention" is the learning model in Applicant's Figure 2, which is the learning model in Applicant's copyright registration, which is the learning model presented to the government in discussions regarding the potential contracts; and that Applicant's claim 1, for example, reads on that learning model.

c. The invention is embodied in the CD-ROM software products that have been licensed to the government. Essentially, the software is an embodiment of the claimed invention.

Reconsideration of the § 132 Sections of the Declaration filed July 15, 2005 is respectfully requested. The Examiner rejects the evidence as insufficient "to prove its commercial success is directly derived from the invention claimed." But the evidence of the commercial success of this invention is factual and not rebutted. The Office Action makes the bald assertion there is no showing that the success was as a result of the invention. However, the "invention" is the software program. The government licensed the learning model of the software. There is no basis to rebut or ignore the commercial success.

Courts have held that licensing establishes a sufficient "nexus" or connection between an invention and commercial success if it can be shown the licensing arose out of recognition and acceptance of the subject matter claimed in the patent. In re GPAC Inc., 57 F.3d 1573 (Fed. Cir. 1995). Although mere existence of a license may not itself overcome a conclusion of obviousness, extensive licensing may support non-obviousness. Metabolite Laboratories Inc. v. Laboratory Corp. of America Holdings, 370 F.3d 1354 (Fed. Cir. 2004). High sales of a patented product provides an inferences of a nexus. Pro-Mold & Tool Co. Inc. v. Great Lakes Plastics Inc., 75 F.3d 1568 (Fed. Cir. 1996).

It is indeed rare that a patent applicant can submit evidence of commercial success of the magnitude of record herein. Furthermore, most of the evidence of licensing is to the U.S. Government. As set forth in the July 15, 2005 Declaration, it is licensed to seven of the largest Federal agencies. It is licensed for use in Government projects supported by eleven U.S. Government agencies. In the Metabolite case, the patent owner had licensed the invention to

eight companies and this was held to be extensive licensing which may support non-obviousness under the secondary considerations of non-obviousness.

With respect to a nexus, the record establishes Applicant showed the high level model of the conception document (the software flowchart or algorithm of Applicant's Fig. 2), to the Government when the Government was seeking a better way to train employees in difficult subject matter. The Government did license Applicant's learning model for a variety of its agencies. The number of government employees using the licensed learning system is large, to say the least. This matches up precisely with the Metabolite and Pro-Mold cases. It is respectfully submitted that the evidence of record supports the secondary indicia of non-obvious based on commercial success.

IV. § 101 REJECTIONS

Independent claims 1 and 16 have been rejected as non-statutory. The final rejection argues that there is no concrete, useful and tangible result, and that they are not in the technical arts. This is respectfully traversed.

Applicant reiterates, and requests reconsideration of the rejection based on, the arguments of record in Applicant's prior response, which are incorporated by reference herein. The U.S. Supreme Court does not recognize the test articulated in the final rejection. In fact, in the recent case of In re Lundgren, BPAI Case Nos. 2003-2088 (September 28, 2005), the U.S. Patent Board of Appeals and Interferences reiterated that the correct view of the law regarding these types of claims is that of the U.S. Supreme Court as cited in Applicant's prior response of record. It specifically rejected the "technical arts" rejection.

However, to advance prosecution of the application, claim 1 has been amended to add in the phrase "in an information processing device". Even though it is a method claim, it is respectfully submitted this clearly alleviates any concern under § 101. This is the same phrase used by cited reference Hatakama to describe its device (*see, e.g.* Hatakama, col. 1, line 11).

Furthermore, claim 16 previously explicitly had in its language "a computer". For consistency, this has been changed to "information processing device".

Claim 11 was not rejected under § 101. It has a computer but, for consistency, the same change has been made. The remainder of claims 1 and 16 are closely parallel to claim 11.

V. § 112 REJECTIONS

The claims have been amended to address each of the concerns in the final rejection under § 112. Specifically, the claims have been amended in a manner which is submitted to overcome these rejections.

VI. § 102 REJECTION BASED ON HATAKAMA

Certain claims have been rejected as lacking novelty based on Hatakama. This is respectfully traversed.

It is respectfully submitted Applicant's prior responses, incorporated by reference herein, show Hatakama does not present a *prima facie* case of anticipation relative to the rejected claims. However, Hatakama is not an effective prior art reference against Applicant's application. Its earliest effective date under 35 U.S.C. § 102(e) is its U.S. filing date of August 22, 1995. *See 35 U.S.C. § 102(e) and MPEP § 706.02(f)(1).* In comparison, the evidence of record shows Applicant's filing date is October 25, 1996, but as discussed previously in this response, a

conception date of the invention occurred at least in early 1995 and at least earlier than the effective date of Hatakama. Please see McKirchy Declaration submitted with July 13, 2005 response (which is incorporated by reference herein).

Furthermore, to supplement Applicant's claim under 37 C.F.R. § 1.131 with respect to Hatakama, please see Supplemental Declaration of McKirchy concurrently filed herewith. It adds further specific facts relative to swearing behind Hatakama.

Because Hatakama is not an effective prior art reference against Applicant's invention, the rejection under 35 U.S.C. § 102 fails and does not present a *prima facie* case of anticipation of Applicant's claimed invention.

VII. § 103 REJECTION - HATAKAMA IN VIEW OF COOK

For the reasons expressed above, it is respectfully submitted that Cook is not a valid reference against Applicant's claims. As such, the combination of Hatakama and Cook does not present a *prima facie* rejection based on obviousness.

Furthermore, as discussed above, Hatakama is not an effective valid reference against Applicant's claims and therefore the combination of Hatakama and Cook does not present a *prima facie* rejection based on obviousness.

VIII. NEW CLAIMS

New claims 21-40 set forth options regarding independent claims 1, 11 and 16. For example, one option is that the levels of sophistication vary from section to section. Another option is that the levels of sophistication vary in type from section to section. Applicant's specification at page 23 supports these claims. As shown in Applicant's specification, the subject

matter to be learned can be broken up into parts or sections. Each part or section can be displayed or otherwise presented to the user. However, not only can the number of levels of sophistication between any two sections vary, the content of the levels can vary. *See also* Applicant's specification page 19.

Similarly, some of the new claims specify that the content of the information to be learned can include not only instruction, but questions, and question feedback. Support can be found in Applicant's specification page 15, first paragraph, as well as Figure 2. The additional instructional options for any of these can be available. This can also help learning of the subject matter.

IX. CONCLUSION

It is respectfully submitted all matters raised in the Office Action have been addressed and remedied and that the Application is in form for allowance. Favorable action is respectfully requested.

This is a Request for Continued Examination (RCE); therefore, please charge Deposit Account No. 26-0084 the amount of $395.00 for the RCE.

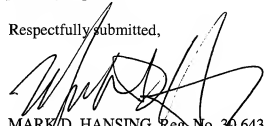
This also is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for two months from June 5, 2006 to August 5, 2006. Applicant is a small entity; therefore, the fee is $225.00.

Applicant submits 20 new dependent claims, therefore, please charge Deposit Account No. 26-0084 the amount of $500.00 for these claims.

Please charge Deposit Account No. 26-0084 in the total amount of $1,120.00 for the RCE, two month extension and additional claims. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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